

REMARKS

Claims 1-25 are currently pending in the subject application. Claim 2 has been amended herein to correct a minor spelling error. A clean version of all pending claims is found at pages 2-5 of this Reply. A marked-up version showing amendments made herein is found at page 9. Favorable reconsideration of the subject application is respectfully requested in view of the comments below.

I. Rejection of Claims 1-25 Under 35 U.S.C. §103(a)

Claims 1-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Emori, *et al.* or Root, *et al.* Reconsideration and withdrawal of this rejection is respectfully requested for at least the following reasons.

The crux of the Examiner's arguments supporting the rejection of claims 1-25 is that "it is well known to make integral that which was separate." However, it is submitted that the Examiner is misinterpreting the case law and drawing erroneous conclusions. For example, in *In re Murray*, 19 CCPA 739, 53 F.2d 541 (1931), which the Examiner relies upon in the Office Action mailed August 14, 2001, the only difference in the appellant's application and the cited references is that in the cited references each longitudinal one-half of the housing is made in three pieces, welded together, while in the appellant's application, two such welded portions are utilized. Thus, the Court determined that the difference did not constitute a patentable distinction. The Court further stated that the fact that appellant's method greatly reduces the cost of production is not sufficient to render his device and method patentable.

The facts in *In re Murray* are substantially different than in the subject application. Applicant is not merely taking two parts of a machine and combining them into one to realize production efficiencies. Rather, Applicant realized the need for a machine diagnostic system that was more reliable and did not require multiple portable recorders or significant manpower to collect machine data. Furthermore, Applicant did not merely attach a portable recorder to a machine, as suggested by the Examiner. Instead, Applicant invented a machine diagnostic system to permanently mount to a machine, which is also protected against environmental contamination and thermal damage. The machine diagnostic system includes a module, which collects data relating to operation of the machine, and a package, which is mounted to an outer mounting surface or the machine. The package includes a container which contains the machine diagnostic module and a heat dissipation device, positioned between the container and the outer mounting surface of the machine, which dissipates heat generated by the machine into the surrounding air; thus, minimizing heat transfer to

the container. These elements were not parts of the machine prior to Applicant's invention. Therefore, the Examiner's assertion that the Applicant is integrating that which was separate before is incorrect.

Furthermore, it is respectfully submitted that Emori *et al.* and Root *et al.*, alone or in combination, fail to teach or suggest all of the claim elements of claims 1-25. For example, claim 1 includes a machine diagnostic system, which is not taught, alone or in combination, by the cited references. Rather, Emori *et al.* and Root *et al.* teach electric apparatuses, such as inverter or converter devices, resistors, transformers, and semiconductor devices. Additionally, claim 1 includes a heat dissipation device that dissipates heat generated by the machine, which is not taught, alone or in combination, by the cited references. Rather, both Emori *et al.* and Root *et al.* are directed towards dissipating heat generated by the electric apparatuses and not the structure that the heat dissipation device is mounted upon.

Claims 23 and 24 include containing the diagnostic module within a container and a tip which engages the container whereby heat is conducted through a base of the fin, which engages the outer mounting surface of the machine, towards the tip and is transferred by convection into the surrounding air. In contrast, both Emori *et al.* and Root *et al.* teach the base of the fin being coupled to the electric apparatus. Emori *et al.* further teaches the tip of the fin suspended in air within the container, while Root *et al.* teaches the tip of the fin is mounted to electric circuit assemblies. Thus, Emori *et al.* and Root *et al.* alone or in combination, do not make obvious claims 23 and 24.

Claim 25 includes a network backbone connected to the machine diagnostic module and a host computer connected to the network backbone able to receive diagnostic data provided from the machine diagnostic module and to allow on-line diagnosis of the machine. A network backbone, a machine diagnostic module, and a host computer are all absent from Emori *et al.* and Root *et al.*. Thus, Emori *et al.* and Root *et al.*, alone or in combination, do not teach or suggest such elements and thus, do not make obvious claim 25.

Additionally, the Office Action fails to show a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Emori *et al.* and Root *et al.* operate to dissipate heat generated from electrical components such as invertors and transistors. Emori *et al.* and Root *et al.* do not mention and are not applicable to dissipating heat from a machine. The Office Action has not met its burden in establishing a *prima facie* case of obviousness.

Accordingly, withdrawal of this rejection is respectfully requested.

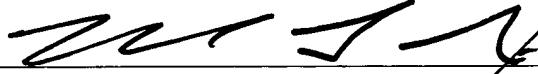
II. Conclusion

The present application is believed to be condition for allowance in view of the above amendment and comments. A prompt action to such end is earnestly solicited.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

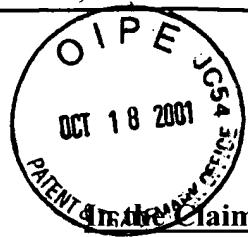
In the event any additional fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

in the claims:

Please amend claim 2 as indicated below.

2. (Amended) The combination set forth in claim 1, wherein the heat dissipation device includes a first set of fins which transfer the heat by [convention] convection into the surrounding air.